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Mario Scholz

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SMITH, GAMBRELL & RUSSELL  
1130 CONNECTICUT AVENUE, N.W., SUITE 1130  
WASHINGTON, DC 20036

EXAMINER

SALVITTI, MICHAEL A

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **ADVISORY ACTION**

### ***Response to Amendment***

The proposed amendments have not been entered, as Claim 5 presents a new limitation that has not previously been addressed on the merits, and would warrant further search and consideration. Furthermore, the presently amended claims present additional new claims without canceling a corresponding number of finally rejected claims.

### ***Response to Arguments***

The following responses are in reply to the document "Remarks" (pages 3-9), received February 12th, 2010. Arguments directed to the amended claims of February 12<sup>th</sup>, 2010 have been given little weight, as the limitations have not been examined on the merits.

**A)** Applicant argues (pages 3-4), with regards to rejection of claims 1-4 under 35 U.S.C. 112, first paragraph, that the claim 4 is enabled with regard to technology known in the art.

In response, claim 4 presents new matter, specifically an open-ended range of compacted bulk density for silica of greater than 120 g/L. The point "120 g/L" is a data point taken from experimental data, with a highest data point of 266 g/L disclosed in the examples. The written specification provides no support for density ranges, and especially for open-ended ranges outside the highest data point, nor was an open-ended range originally claimed. Since 266 g/L is the upper limit provided in the

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examples, values above this limit have been held to be unsupported, thus invoking an issue of new matter.

**B)** Applicant argues (page 4), regarding rejection of claims 1-4 under 35 U.S.C. 112, second paragraph that the relative terms “very high tear propagation resistance” and “effective amount” are well-known in the art. In response, for simplification of issues for appeal, these rejections have been withdrawn. As undefined variable and relative terms, these terms have been given broadest reasonable interpretation as defined in the previous rejection.

**C)** Applicant's arguments (pages 4-5) with respect to rejection of claims 1-3 under 35 U.S.C. 102(b) to *Azechi et al.* (USPN 6,331,588) have been fully considered but they are not persuasive.

Applicant argues (page 5) that *Azechi* does not teach structurally modified pyrogenic silica. In making the determination as to whether *Azechi* contains these features, the Office looked to the applicant's specification as a means of identifying what these limitations mean. Explicit definitions were not given in the specification, so as a means of determining the scope, the Office looked at the processes by which the silica was made and treated. In the instant specification, “structurally-modified” appears to mean mechanical agitation (see page 3, lines 9-15 of instant specification). *Azechi* teaches this feature (*Azechi* col. 5, lines 10-23). In the instant specification, pyrogenic is shown to mean flame hydrolysis (see page 3, lines 22-26); indeed *Azechi* teaches this feature (col. 4, line 59).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "low structure", DBP, bulk density) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**D)** Applicant's arguments (pages 5-6) with respect to rejection of claims 1-3 under 35 U.S.C. 103(a) to *Azechi et al.* in view of *Bergstrom et al.* (USPN 6,384,125) have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, almost ½ of the potential silica modifiers in *Azechi* are vinyl-functional (col. 5, lines 25-63). As such, this limitation has been taught with sufficient specificity. *Bergstrom* is further applied to show that vinyl modification is routinely known in the field of surface-modified silica fillers utilized in silicone resins, and provides a motivation for doing so (increasing the affinity of the filler to the polymer; *Bergstrom* col. 2, lines 34-40).

In response to applicant's arguments, the recitation "very high tear-propagation resistance" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely

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recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). As noted in the previous Action, this indefinite term was examined with the interpretation that compositions containing the required limitations would implicitly possess "very high tear propagation resistance".

**E)** Applicant's arguments (pages 5-6) with respect to rejection of claim 4 under 35 U.S.C. 103(a) to *Azechi et al.* in view of *Bergstrom et al.*, as applied to claim 1, further in view of *Kobayashi* (US 2002/007412) have been fully considered but they are not persuasive.

In response to applicant's arguments concerning *Kobayashi*, *Kobayashi* teaches that problems of flowability may be avoided by using specific bulk densities of silica (¶ [0023]), and further teaches densities with sufficient specificity to those of the instant invention (100-300 g/m<sup>2</sup> in *Kobayashi* vs. 120-266 g/m<sup>2</sup> in instant specification). As such, at the time of the invention, it would have been obvious to a person having ordinary skill in the art to optimize the bulk density of *Azechi* (if not all ready inherent) to greater than 120 g/L, with the motivation of obtaining a resin having superior flowability (*Kobayashi* ¶ [0023]), which a person having ordinary skill in the art recognizes as being quite important in the preparation process of viscous resins.

**F)** Applicant's arguments (page 7) with respect to rejection of claims 1-3 under non-statutory obviousness-type double patenting to USPN 7,563,839 made in view of USPN 6,384,125 to *Bergstrom* have been fully considered but they are not persuasive.

In response to applicant's arguments that '839 teaches conductive furnace black, it is noted that the transitional phrase "containing" has been examined with the scope of being equivalent to "comprising". As such, the claim is open-ended with regard to limitations. See MPEP § 2111.03. The claimed invention of '839 in view of *Bergstrom* is a species of the presently claimed genus (MPEP § 2131.02).

**G)** Applicant's arguments (pages 7-8) with respect to rejection of claims 1-2 under non-statutory obviousness type double patenting to copending application 10/591,609 have been fully considered, but they are not persuasive.

In response to applicant's arguments that the copending application has been allowed, it is noted that this allowance occurred after the previous Action was sent. The allowance was mailed 12/22/2009 (with Examiner's Amendment), and the Final Action for the instant application was mailed 12/08/2009. Further consideration as to the merits of patentability of the instant application will be determined in future actions in view of the allowed claims for application 10/591,609.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL A. SALVITTI whose telephone number is (571)270-7341. The examiner can normally be reached on Monday-Thursday 8AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

/M. A. S./  
Examiner, Art Unit 1796